



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In re Patent of: Amin et al.)
Assignee: Pharmacia & Upjohn Co.)
Patent No.: 4,902,683)
Issued: February 20, 1990)
For: Crystalline Cephalosporin)
Hydrohalide Salts)

RECEIVED

APR 14 2004

OFFICE OF PETITIONS

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO ACCEPT DELAYED PAYMENT OF MAINTENANCE FEE

The Assignee/Owner of U.S. Patent No. 4,902,683 submits a Petition to Accept an Unavoidably Delayed Payment of a Maintenance Fee, pursuant to 37 C.F.R. § 1.378(b), for U.S. Patent No. 4,902,683, which issued February 20, 1990 from U.S. Application No. 07/312,401, filed February 17, 1989.

Pursuant to 37 C.F.R. §§ 1.378(b)(1) and (2), the Assignee/Owner of U.S. Patent No. 4,902,683 includes a check in the amount of \$3,850.00 (as well as authorization for any further charges) for: (i) the required maintenance fee set forth in 37 C.F.R. § 1.20(g) for maintaining an original patent in force beyond twelve years after the original grant, and (ii) the surcharge set forth in 37 C.F.R. § 1.20(i)(1).

Pursuant to 37 C.F.R. § 1.378(b)(3), the Assignee/Owner of U.S. Patent No. 4,902,683 also includes Declarations from Julie K. Lyons, Edward F. Rehberg, Deborah A. Tucker, and Thomas A. Wootton. These Declarations show that: (a) the delay in paying the maintenance fee under 37 C.F.R. § 1.20(g) for U.S. Patent No. 4,902,683 was unavoidable since reasonable care was taken to ensure that this maintenance would be paid timely, and (b) this Petition was filed promptly after the Assignee/Owner became aware of the expiration of the patent.

08/31/2004 AKELLEY 00000015 132490 4902683

01 FC:1460 130.00 DA

04/13/2004 MAHEDI 00000009 132490 07312401

01 FC:1559 3850.00 DA

Specifically, the Declaration from Julie K. Lyons sets forth the facts regarding the delayed payment, based upon Ms. Lyons' direct knowledge of the facts. Ms. Lyons' declaration enumerates the steps that were taken to ensure the timely payment of the maintenance fees for U.S. Patent No. 4,902,683. As indicated in Ms. Lyons' Declaration, the Owner/Assignee of U.S. Patent No. 4,902,683 uses and relies upon a widely available commercial service (PC Master; Master Data Center; Southfield, MI) to ensure the timely payment of maintenance fees. An error in a docketing system entry for U.S. Patent No. 4,902,683, apparently by inconsistent statements from Master Data Center, caused the delayed payment of the maintenance fee under 37 C.F.R. § 1.20(g) for U.S. Patent No. 4,902,683.

The Declaration from Deborah A. Tucker shows that the Owner/Assignee of U.S. Patent No. 4,902,683 had a back-up system in place to ensure that if a maintenance fee on a patent was not paid by the outside commercial service as the result of such an error, the patent would not lapse due to non-payment.

The Declaration from Edward F. Rehberg shows that the Owner/Assignee of U.S. Patent No. 4,902,683 became aware of the expiration of U.S. Patent No. 4,902,683 on March 3, 2004 in the course of a routine database search of issued U.S. Patents using the LEXIS-NEXIS database, and that the Owner/Assignee took steps to ensure that this Petition was filed promptly.

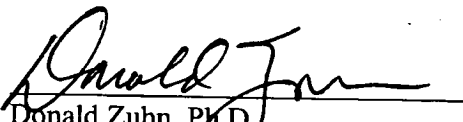
The Declaration from Thomas A. Wootton shows that the Owner/Assignee of U.S. Patent No. 4,902,683 took prompt steps to investigate and correct the error immediately after the Owner/Assignee became aware of the expiration of U.S. Patent No. 4,902,683.

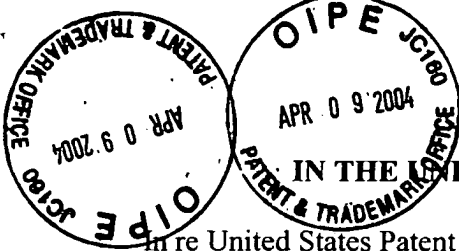
If any Patent Office official believes it to be beneficial, he or she is invited to contact the undersigned representative by telephone at 312-913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

Dated: April 2, 2004

By:


Donald Zuhn, Ph.D.
Reg. No. 48,710



In re United States Patent No. 4,902,683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent No. 4,902,683

Patentees : Amin et al.
Assignee : Pharmacia & Upjohn Company
Issue Date : February 20, 1990

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Box Petition.

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DECLARATION

Sir:

I, Deborah A. Tucker, the undersigned, a citizen of the United States and residing at 1010 Miller Road, Kalamazoo, MI 49001, declare and say as follows:

1. I have been employed by The Upjohn Company and its successor company Pharmacia & Upjohn Company now a wholly owned subsidiary of Pfizer Corporation for 32 years beginning as a Legal Secretary and being promoted to a Legal Assistant in 1989.
2. I assumed the Legal Assistant position in 1989, from then through 2003, it was my responsibility during the normal course of business as an employee of The Upjohn Company and Pharmacia & Upjohn Company to receive correspondence relating to all United States annuity matters. I would receive Maintenance Fee Statements (PTOL-439), Maintenance Fee Reminder forms (PTOL-440) and Notices of Expiration (PTOL-441). If I received any notice that a US maintenance fee was not paid when it was due or that a patent had gone abandoned I verified that the non-payment or abandonment was intentional.
3. I was informed by Edward F. Rehberg, applicant's attorney, on March 8, 2004, that US Patent 4,902,683 had lapsed for failure to pay maintenance fees.

4. I believe that if I had received a reminder that maintenance fees were due for US Patent 4,902,683, I would have taken steps to assure that the maintenance fee was paid or that a decision had been made not to pay the maintenance fee.
5. I believe that if I had received a Notice of Expiration for US Patent 4,902,683, I would have taken steps to verify that the abandonment was intentional.
6. I do not believe that I have or ever had records or information, that a decision was made to allow US Patent 4,902,683 to lapse or go abandoned.
7. I do not recall ever having been instructed to allow US Patent 4,902,683 to lapse or go abandoned.
8. I believe that I was reasonable in my behavior and took reasonable steps to ensure that maintenance fees were paid for United States Patent No. 4,902,683 and that the lapse of US Patent 4,902,683 was unavoidable on my part.

I hereby declare that all statements made herein are of my own knowledge, and I believe them to be true, and further that these statements are made with the knowledge that willful false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Deborah A. Tucker
Deborah A. Tucker

1 April 2004
Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent No. 4,902,683

Patentees : Amin et al.
Assignee : Pharmacia & Upjohn Company
Issue Date : February 20, 1990

Mail Stop Petition
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION

Sir:

I, Julie K. Lyons, the undersigned, a citizen of the United States and residing at 6797 Country View Drive, Kalamazoo, MI 49009, declare and say as follows:

1. I have been employed by The Upjohn Company and its successor company Pharmacia & Upjohn Company now a wholly owned subsidiary of Pfizer Corporation for 24 years as a Legal Assistant.
2. I was employed by the Pharmacia & Upjohn Company as a Legal Assistant during the period around July 17, 1998 (hereinafter the "relevant time period") when I was informed that U.S. Patent No. 4,902,683 obtained a Patent Term Extension pursuant to 35 U.S.C. § 156.
3. It was my responsibility during the relevant time period to enter docket entries related to U.S. Patent matters into the internal patent docketing system of the Pharmacia & Upjohn patent department.
4. Pharmacia & Upjohn during the relevant period and thereafter has used and continues to use for docketing patent matters and paying maintenance fees for issued patents a widely available commercial service marketed under the name PC Master by Master Data Center located at Master Data Center, 300 Franklin Center, 29100 Northwestern Highway, Southfield, Michigan 48034.

5. At some point prior to the relevant period I made an inquiry of the Master Data Center as to the proper way to make a docket entry for a patent whose term had been extended pursuant to 35 U.S.C. § 156 (hereinafter an "extension patent").

6. Pursuant to my inquiry with Master Data Center I was informed by Ms. Liz Bevier, a Master Data Center employee, that the existing docket entry for an extension patent should be modified by indicating in the "Case Type" field of the record that it was a "J" record. I recorded these instructions in my procedure book at page 24. My procedure book is attached as **Exhibit A**.

7. It thereafter became my routine practice, during the ordinary course of business, during the relevant time period and thereafter to modify the existing record for extension patents to indicate that they were a "J" record with the belief and expectation that the maintenance fee due for the patent associated with such records would be paid by Master Data Center.

8. During the relevant time I believe I modified the existing docket entry for United States Patent No. 4,902,683 by indicating in the "Case Type" field of the record that it was a "J" record pursuant to my routine practice and acting upon the advice of Master Data Center.

9. I was informed by Edward F. Rehberg, applicant's attorney, on March 3, 2004, that U.S. Patent No. 4,902,683 had lapsed for failure to pay maintenance fees.

10. On March 3, 2004, I asked Master Data Center why the maintenance fees for U.S. Patent No. 4,902,683 had not been paid. Pursuant to my inquiry I was informed by Ms. Jennifer Oddo of Master Data Center that Master Data Center does not pay annuity payments on records designated with a "J."

11. On March 8, 2004, I was informed by my supervisor Deborah Tucker (who docketed foreign matters) that it was her belief that the proper way to create a docket entry for an extension patent was to create a new record designated with a "J" while leaving the existing record unmodified. It is my belief that Ms. Tucker and I received inconsistent instructions from Master Data Center.

12. I believe in light of the facts:

(a) that I relied on the apparently inconsistent instructions of Master Data Center to modify the existing record for extension patents to indicate that they were a "J" record,

(b) that Master Data Center inexplicably did not pay the maintenance fee due on August 20, 2001, for U.S. Patent No. 4,902,683 with any warning to Pharmacia & Upjohn Company, and

(c) . that I was reasonable in my behavior and took reasonable steps to ensure that maintenance fees were paid for U.S. Patent No. 4,902,683 and that the lapse of U.S. Patent No. 4,902,683 was unavoidable on my part.

I hereby declare that all statements made herein are of my own knowledge, and I believe them to be true, and further that these statements are made with the knowledge that willful false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Julie K. Lyons
Julie K. Lyons

April 1, 2004
Date



US DOCKETING PROCEDURES

WEEKLY DOCKETS

Distribution: Jennifer: Tom, Tim
Becky: Lucy, Steve Nesbit
Barb: John, Jean
Carolyn: Mary, Nelson
Valerie: Ed, Jonathan (Tues, Thurs, Fri)
Linda: Ed, Jonathan (Mon-Wed)

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CURRENT VERSION OF THIS DOCUMENT ON SHARED DRIVE

When the completed report comes to the screen, cut and paste it into our version of Word. Insert MDReport (found under Legal icon) at top of report. Click on Page Layout and change top, bottom and both side margins to .5.

Drop Dead Docket: **Header card:** 'From 05OC2002 to 18OC2002' move each date forward 7 days. (The first date is the Saturday of the week just past; the second date is Friday, 2 weeks ahead. This makes a 14-day range.)
Search card: ((RANGE ACT.DUE.DT.PL(1) '05OC2002' '18OC2002')
move each date forward 7 days.

2 copies on hot pink, one for attorney and one for admin
Both copies distributed at Monday morning meeting
or hand delivered to each admin early Monday morning
2 copies on white for DAT/DJM; Original to JKL

Attorney Docket: **Header card:** 'From 01JA1999 to 28FE2003'
The final date will be the last date of the fourth month from current month, i.e., current month is October 2002, final date will be 28FE2003.
Search card: Same date range as above, BUT change in 3 places:
((RANGE ACT.INTAC.DT.PL(1) '01JA1999' '28FE2003')
(RANGE ACT.DUE.DT.PL(1) '01JA1999' '28FE2003')
(RANGE ACT.INTAC.DT.PL(1) '01JA1999' '28FE2003')

2 copies on yellow, one for attorney and one for admin; Original to JKL

In-Prep Docket: **Header card:** 'From 01JA1999 to 28FE2003'
The final date will be the last date of the fourth month from current month, i.e., current month is October 2002, final date will be 28FE2003.
Search card: (RANGE ACT.INTAC.DT.PL(1) '01JA1999' '28FE2003')

2 copies on blue, one for attorney and one for admin; Original to JKL

Tech Docket:

Header card: 'From 01JA1999 to 28FE2003'

The final date will be the last date of the fourth month from current month, i.e., current month is October 2002, final date will be 28FE2003.

Search card: Same date range as above, BUT change in 3 places:

((RANGE ACT.INTAC.DT.PL(1) '01JA1999' '28FE2003')

(RANGE ACT.DUE.DT.PL(1) '01JA1999' '28FE2003')

(RANGE ACT.INTAC.DT.PL(1) '01JA1999' '28FE2003')

2 copies on white for DAT/DJM; Original to JKL

Confirmation Docket: No date parameters required

2 copies on white for DAT/DJM; Original to JKL

B1: Issued patent (no pre-grant publication)	US 6,654,321 B1
B2: Issued patent (with pre-grant publication)	US 6,654,322 B2
A1: Application (first publication)	US 2001/0001111 A1
A2: Second or subsequent republication of appl	US 2001/0002222 A2
A9: Correction of published application	US 2001/0003333 A9
E: Reissue Patents	US RE12,345 E
H1: Statutory Invention Registration (SIR)	US H2345 H

GATT

Beginning June 8, 1995, patent applications will have a life of 20 years from national patent application filing date. Applications filed before that date will be eligible for either 17 years from patent issue date or 20 years from filing.

For applications first filed Provisional, the patent expiration date will be 20 years from the Non-provisional filing date.

For applications converted from Provisional to Utility, the patent expiration date will be 20 years from the Provisional filing date.

DOCKET NUMBERS

Explanation of Old Docket (Case) Numbers KZ-2720 – KZ-6337

KZ-6337	First US utility application or first Provisional application
KZ-6337.N CP or CN1	First US application at end of provisional year
KZ-6337.1 CP, .2 CP, .3 CP	Continuation-in-Part
KZ-6337 CN1, CN2, CN3	Continuation
KZ-6337 DV1, DV2, DV3	Divisional
KZ-6337.P CP or CN1	PCT filing
KZ-6337.P CP or CN1	US application filed thru US Receiving Office (PCT) from PCT using form 1390; record will show Filing Type "Patent Cooperation Treaty" and Parent Number will be PCT serial number. The PCT record Sub Status will be "N"

(filed National)

KZ-6337.P PCT foreign filings
KZ-6337.1; .2, .3 Non-PCT foreign filings

New docket (case) numbers are generated by MIPS.

00000.PRO1, PRO2, PRO3 (Provisional)
00000.US1, US2, US3 (Nonprovisional)
00000.US1 DV1, DV2, DV3 (Divisional)
00000.US1 CP1, CP2, CP3 (Continuation-in-part)
00000.US1 CN1, CN2, CN3 (Continuation)
00000.PCT1 US1 for US National filed from a PCT (country is "US" and Filing Type is "P" and Sub Status is "N.")
00000.PCT1, PCT2, PCT3 (PCT)
00000.NONPCT1, NONPCT2, NONPCT3 (NONPCT, i.e., Taiwan); add DV if Divisional

00000.RE1 (Reissue)
00000.PTE1 (Patent Term Extension)

ATTORNEY DOCKET ASSIGNMENTS

Any changes of attorney assignment on dockets must be copied to JKL, DAT, and DJM.

OUTSIDE COUNSEL

If a case series is being handled by outside counsel:

For US cases: Enter counsel name as External Agent on first screen.

For all cases: Enter Counsel Firm, Counsel Type (Intermed/Outside), and Counsel's Ref. on Counsels card.

For all BACE cases: Enter Counsel Firm, Counsel Type (Intermed/Outside), and Counsel's Ref. on Counsels card. Also enter ELAN code and case number reference under "Counsel's Ref."

For all actions requiring response, enter code "OUT" under "Responsible Attorney." The only exception to this would be if the outside counsel needs a response from our internal attorney. In this instance, we would not use "OUT."

FORMAL PAPERS

The execution of formal papers (declaration and assignment) will be handled by DJM. Upon completion of papers, DJM will make **two** photocopies of the complete set and will place one copy at the bottom of the center clip in the file wrapper and give the other copy to DAT. She will retain originals until submitted to PTO.

Provisional: Assignment only
Nonprovisional and PCT: Declaration and Assignment

SUBMISSION OF PROPOSED INVENTION

A **Submission of Proposed Invention** will be received either electronically (via email and attachment) or by paper. If submitted by paper, an electronic copy is also required. (The electronic SPI must be followed by a paper copy signed by the proposed inventor(s) and two witnesses for each inventor.) When the electronic SPI is received, add to the first page of the SPI after "PRIVILEGED AND CONFIDENTIAL" and before "Short Descriptive Title" a line, "Docket Number XXXXX." Save on shared drive under folder "Submission of Proposed Invention" as "XXXXX.doc."

Print Submission of Proposed Invention. Make brown file pocket with extended end label to contain master (blank labels on JKL's counter) and place in numerical order in file room.

Via email forward the email request from the inventor to JDD with the message, "Please assign to an attorney." Move the sent email message to JKL's Personal mail folder "SPIs Holding."

When JDD has assigned an attorney, in MIPS, File, New, Patent will bring to screen the next available docket number. Use of the Disclosure module has been discontinued.

In Patent Module: Country: US
Case Type: L
Index: 1
Current Owner:
Convention Type: First Filed Case

Inventors are not added to the record until the application is filed.

Via email send the appropriate message from the samples below. Address message to #dl-uskzo-32cases, plus all names listed in SPI*. This will announce that the docket number has been given out.

*If BACE, also copy to Susanne R. Haadsma-Svensson.

*If assigned to the St. Louis docket, also copy Patricia Keller.

*If assigned to Karen King, Kalim Fuzail, David Fournier, also copy to Jim Forbes.

When more than one Provisional is filed, if additional inventors are added to the later filed applications, create the WO record listing all inventors and send email notification to DAT.

SAMPLES OF SPI EMAIL MESSAGES:

BACE only: In addition to others listed on SPI, copy Susie Haadsma-Svensson, James P. Beck, Donald Frail, Michael Bienkowski, Suvit Thaisrivongs.

For SPIs assigned outside Kalamazoo, i.e., Jim Forbes, Karen King, etc.:

The following docket number has been given out based on a Submission of Proposed Invention and has been assigned to the docket of Jim Forbes.

For ALL St. Louis-assigned cases (including Cox-2), copy Patricia Keller (per TAW 9/30/02).

The following docket number has been given out based on a Submission of Proposed Invention and has been assigned to the docket of *.

Docket No:

Title:

People who may have contributed to the invention:

If attorney is requesting a new docket number in lieu of Submission of Proposed Invention:

The following docket number has been given out at the request of * and will be placed on his/her docket.

Docket No:

Title:

People who may have contributed to the invention:

If multiple SPIs are submitted in one email and they contain essentially the same list of people to be copied, I combine them as follows:

The following docket numbers have been given out based on Submissions of Proposed Invention and have been assigned to the docket of *.

Docket No:

Title:

People who may have contributed to the invention:

Docket No:

Title:

People who may have contributed to the invention:

Docket No:

Title:

People who may have contributed to the invention:

DOCKET NUMBERS TRANSFERRED TO OTHER SITES

Occasionally, a Submission of Proposed Invention received in Kalamazoo from Kalamazoo inventors will be transferred to the St. Louis, Stockholm, Helsingborg, Italy or New Jersey docket.

In the Patent module the Site code will be listed as ST. LOUIS (USSTL), STOCKHOLM (EUSEST), HELSINGBORG (EUSEHE), ITALY (EUIT), or NEW JERSEY (USNJ).

OUTGOING PTO MAIL - DELIVERY TO POST OFFICE

All mailings to USPTO (other than Mail Stop PCT)) must be ACCO-bound or stapled because the PTO cannot guarantee that papers clipped together will not be separated.

All US patent applications are mailed Express Mail (preprinted label), either to MAIL STOP PROVISIONAL PATENT APPLICATION or MAIL STOP PATENT APPLICATION.

All PCT applications are mailed Express Mail to Cantwell (preprinted label).

All 1390 national phase applications and all mail sent to PTO during PCT prosecution must be mailed Express Mail (preprinted label), MAIL STOP PCT.

INCOMING PTO MAIL

Incoming USPTO mail is opened and stamped by DJM, who will pull US file wrapper and clip the incoming communication to the front of the wrapper and give to JKL for docketing. After docketing JKL will place the paper in the wrapper, stamp "Response due" at the top and write in due date. She will then give the wrapper to the attorney's administrative assistant.

RETURN POSTCARD RECEIPT

DJM will add PTO stamped receipt date as Completed date.

For all new applications: Enter serial number and filing date on Main Screen. Also enter serial number on JKL's m:\excel\dep.xls (PTO Deposit Account record) for that case number.

For applications Expressly Abandoned: Enter date postcard is stamped as received by PTO in Completed date in record. On Main Screen change Status to "I", Substatus to "B" and Expiration Date as date stamped by PTO on postcard.

For Notice of Appeal Postcard Receipts: Write on postcard "BRIEF DUE x/x/1998" (2 months from date stamped by PTO on postcard).

REQUESTS FOR FREEDOM TO OPERATE OPINIONS

Send email message to SLN: Please assign to an attorney. When he replies, forward the message on to that attorney with the attachment. "This has been assigned by Steve Nesbitt to the docket of _____."

APPLICATIONS – UTILITY

A first-filed utility patent application record will need to have "Priority Date" added since this will not be added by the system. This will ensure that the record gets considered for international filing.

APPLICATIONS - PROVISIONAL

Provisional applications are filed using form 53.P and a filing fee of \$160 is paid on submission to the PTO (2 extra copies for PTO stamped "DEPOSIT ACCOUNT").

On front page of 53.P will be listed the number of pages for Specification, Claims, Drawings, and Abstract. Check to be sure this is correct.

Admin will circulate form A14.P to advise that case has been filed.

Add Application # ("0" until postcard is received from PTO with serial number stamped on it) and Application Date (date case is sent to PTO). System will automatically change Status to "F" and will add code "File Complete Application" and a Due Date. Copy Due Date into the Int. Action Date field. Add inventors to the record.

The system will also add the following codes which are not used by the Kalamazoo site. Shut them off using "01JA2003," an artificial date, in the Completed Date field.

- Review USA – 6 Mo
- Review USA – 9 Mo
- Review USA – 11 Mo
- Review Foreign– 6 Mo
- Review Foreign– 9 Mo
- Review Foreign– 11 Mo

Add code "FPA" with Action Due Date and Deadline Date 3 months from filing date. Under "Responsible Atty" add initials of attorney's admin or code "OUT" for papers being completed by outside counsel. Under "Action Notes" add "ASSIGNMENT."

Add code "FLR" with Int. Action Date and Deadline Date 3 months from filing date. Under "Responsible Atty" add initials of attorney's admin or code "OUT" for papers being completed by outside counsel.

NAMING OF INVENTORS

When a Provisional application is filed, the attorney can choose to name or not to name the inventors. If one inventor is named, all must be named. If inventor names or addresses were not provided, the PTO will send a Notice of Incomplete Application. Under Inventors in Patent module, add the names when determined.

AUTHORIZATION TO SIGN

An attorney or patent agent is authorized to sign all papers related to an application whether or not covered by a power of attorney with the following exceptions, for which the attorney must have a power of attorney:

- Fee Address form
- Power to Inspect a File Wrapper

APPLICATIONS – SUBSEQUENT PROVISIONALS

In most instances, the nonprovisional application, PCT and non-PCT applications will be filed within one year from filing the first provisional. If more than one provisional is filed (01000.PRO1, 01000.PRO2, 01000.PRO3), the code "File Complete Application" can be shut off using artificial date 01JA2003.

APPLICATIONS – US NONPROVISIONAL

When a Provisional application record is created, the system inserts a code FIL (file by due date) and a Due Date for filing the Nonprovisional case. The Nonprovisional case will be filed in the USA 2 weeks before the due date, preferably on the day after the PCT is filed so that the two applications will have the same filing date.

Copy the Provisional record to create the new Nonprovisional case on the date of filing.

Change Case Type to Regular.
 Cut and move Application Number to Parent Number
 Cut and move Application date to Parent Filing Date.
 Add "0" for Application Number until Serial Number is received.
 Add date of filing to Application Date.
 Click on tab "Linked Files" and erase the link. Save.
 Check to be sure inventor list is correct.
 Add Action Codes:

	Due Date	Int. Action Date	
FLR	3-month date	3-month date	Admin initials in Responsible Att
FPA	6-month date	2-month date	Admin initials in Responsible Att

The system will add Published. Copy Due Date to Int. Action Date. Add either JL or OUT in Res Atty.

The system will also add the following codes which are not used by the Kalamazoo site. Shut them off using "01JA2003," an artificial date, in the Completed Date field.

Foreign Filing – 6 Mo
 Foreign Filing – 9 Mo
 Foreign Filing – 11 Mo
 Foreign filing deadline

If a decision is made by the GPC that a provisional will be filed ONLY in the US and not PCT, create a US in-prep record. Add code FIL with Internal Action Date 1 month before provisional expiration date. Click on tab "Linked Files" and erase the link.

Numbering of Nonprovisional Application for old docket numbers (4 digits) only: Enter the entire Nonprovisional docket number in the Docket Number field as KZ-XXXX.N CP (or CN1). Do not enter P or C in the Relation Type field. This will ensure that the rules calculation can figure the patent expiration date accurately.

At this time inactivate the Provisional record(s) by adding Nonprovisional filing date in the Completed field of code "FIL" and changing Status Code to "I." The Expiration Date will already be in the record

APPLICATIONS - NONPROVISIONAL FILED WITH ACCOMPANYING DECLARATION AND ASSIGNMENT:

If it is decided that the Nonprovisional Declaration and Assignment are to be filed simultaneously with the case, the admin will prepare the Declaration and Assignment and give them to DJM, who will contact the inventors to sign.

JKL or DJM will merge M:\30A.PAT. Sign and make 2 copies:

one copy to the admin
 one copy for the Deposit Account

Staple original, signed 30A.PAT to the Assignment

Assemble for mailing as follows:

Transmittal
Declaration
Assignment with its cover letter attached (30A.PAT)
Application

MD Main: Add serial number "0" and filing date.
Add code "R" (Assignment Recorded).

Action: Add code FPA (FORMAL PAPERS) and Completed date (application filing date).
Add code ASG (Record Assignment) and date assignment is submitted for recordal.
Add code FLR (Filing Receipt) with Int. Action Date and Due Date 3 months from filing date.
The system will insert code IDS (INFO DISCLOSURE).

APPLICATIONS - NONPROVISIONAL FILED WITHOUT DECLARATION AND ASSIGNMENT

MD Main: Add serial number "0" and filing date.

Action: Add code FPA (FORMAL PAPERS) with Int. Action Date of 2 months from filing date of application and Deadline Date 6 months from filing date of application. Add initials of admin under Resp. Party #1. Papers will be given by admin to DJM for signature by applicants. **DO NOT** fill in Action Taken or Completed dates. Check accuracy of names, addresses and cross references. See **COMPLETION OF NONPROVISIONAL APPLICATION...** below.

APPLICATIONS – PUBLICATION OF US NONPROVISIONALS

When a new Nonprovisional record is created, the system inserts a code "Published" with a due date of 18 months from filing date of application. If due date passes and the application has not received a Notice of Publication, add dummy completed date (i.e., 01JACurrent Year) (whether inside or outside counsel).

APPLICATIONS – PCT

Procedures for PCT cases filed by OUTSIDE ATTORNEYS:

Upon receipt of a copy of a PCT case filed by outside attorneys, DJM will make one complete copy of that material for DAT before passing the case on to JKL.

Procedures for PCT cases filed from Kalamazoo:

DAT prepares a list of cases eligible for international filing and the KPC reviews the cases and gives instructions. Decisions are finalized at GPC meeting. At the appropriate time DAT will send JDD a memo listing the cases to be filed international for his final approval. DAT will then send a memo to each attorney giving instructions and a target date.

PCT only: Target date 2 weeks before end of convention year

PCT + additional non-translation country: Target date 2 months before end of convention year

DAT will have prepared transmittal pages, postcard and letter to Cantwell. JKL signs fee sheet.

MD Main: DAT will have created a record for the PCT case, status "D." Bring record to screen and add Relation Type "P" or "C" and Filing # (if Relation Type is "C"). Click on Save; prompt will appear: "Primary key has changed. Would you like to copy this record?" Click on "No."

Add Application # ("0" until fax of postcard containing serial number is received from Cantwell) and Application Date (one day after application is sent Express Mail to Cantwell; or Monday's date if application is mailed on Friday; or next day after a holiday).

Action: Add code FPA (Formal Papers) with Int. Action Date of 2 months from application filing date, Due Date 6 months from application filing date, and initials of admin under Res. Party #1. Admin will give papers to DJM for completion by inventors. When papers are completed, DJM will fill in Completed Date and change Resp. Party #1 to "JKL." Place in PCT declarations folder in file drawer marked "ISSUE FEES/ DECLARATIONS/ ASSIGNMENTS."
The system will add Codes and Due Dates for PRE (Demand); NF2 (Filing Chapter II), which prints out on dockets as "FILING CHAPTER II."

The system also adds a code NAF (NAT'L FILING). Insert Stop Code NAX (NOT FILED – FILING CHAPTER II) for NAF and delete due date.

For cases handled by outside counsel: When DAT creates the in-prep PCT record she will add a code CAD (Check Inventors Address) with both due dates 28 months from priority date. This will prompt AAs to notify outside counsel of any inventor address changes.

Assemble for mailing as follows (DO NOT PUNCH):

Cantwell letter
Postcard
Letter to PCT
Request (with 2 copies of fee sheet stapled to back of fee sheet, stamped **DEPOSIT COPY** with fee and account number circled in red)
Formal papers
Application

Make 3 copies of everything except application: 1 – DAT; 1 – admin (which she will place in file wrapper); 1 – JKL (for docketing and Deposit/Account).

APPLICATIONS (PCT) - NATIONAL STAGE

Beginning June 7, 1995, all PCT applications entering national stage in the US will be filed using form 1390 and case number remains the same as PCT. With the use of Provisional Applications as the first filing, filing of this stage in the US will be rare. However, if it is decided to file 1390, follow the procedures below.

The Declaration and Assignment for the PCT application are prepared as soon as the serial number is received. At the national stage, the original, signed Declaration, along with form 1390 (in triplicate for Deposit Account) is sent to the Patent Office (MAIL STOP PCT) before one year from the convention (original filing) date. It is not necessary to send a copy of the application. The case number of the national phase remains the same as the PCT case number and the same file wrapper is used.

Complete transmittal mailing certificate. JKL will check to see that the following items are included:

- ☐ Oath or Declaration
- ☐ IPER
- ☐ Preliminary Amendment (there may not be one)

The Assignment can be recorded on the same day using form m:30.pat (prepared by JKL). If the case is filed during her absence, the Assignment can be held for recordal until her return.

MD Main: Bring up the PCT record. Change Country to "USA. Leave Filing Type as "P" (Patent Cooperation Treaty). If that isn't already the designation, add it. Save as new record.

The Application Date will be the date application is submitted by Express Mail. The Parent # will be the PCT # and Parent Date will be PCT filing date. The Application # will be "0" until the postcard is received.

Add Action code NAX with Due Date being the date the application was filed 1390. (No need to add date in Int Action.) Save. The system will then automatically docket Info Disclosure Stmt Due and Published. Now shut off the NAX code with a completed date.

Add codes FLR and ACC (Accepted by PTO) with internal and final due dates 3 months from filing. Add Admin's initials under "Responsible Atty."

At this time, if the PCT has already been filed foreign, mark the PCT record Status "I," Substatus "N" (Filed National) and add Expiration Date (date of filing US national).

APPLICATIONS - CONTINUATION/DIVISION

Form 53.B is required. Make 4 copies of the form as follows:

2 copies for the Deposit Account (stamp the copies DEPOSIT COPY and circle fee and account number in red);

1 copy for admin

1 copy for JKL for Deposit Account.

A xeroxed copy of the case as originally filed including oath/declaration must be sent. Use the most recently filed case requiring an oath. Preferably the case would be Accobound. No new formal papers are required.

MD Main: Bring up the record for the case which will be the parent of the Rule 60. Add Relation Type "C" or "D" and Filing #. Save. A prompt will appear: "Primary key has changed. Would you like to copy this record?" Click on "Yes."

Move Application # of the record just copied to Parent # field. Move Application Date to Parent

Date. Add Serial No. "0" and Filing Date.

In Divisional Application, did attorney cancel any claims? Be sure to check for extension of time.

APPLICATIONS - CONTINUED PROSECUTION (NON-PROVISIONAL)

Filing of File Wrapper Continuations under Form 62 is discontinued. Continued Prosecution Applications (CPA) are now filed using IPLS Form 53D. Make 5 copies of the form as follows:

- 2 copies for the Deposit Account (stamp the copies DEPOSIT COPY and circle fee and account number in red)
- 2 copies for admin
- 1 copy for JKL for Deposit Account

The parent file wrapper is used, using tabs to separate prosecution of the new case. The serial number will remain the same as the parent case, a new filing date will be assigned and no new formal papers are required.

MD Action: In case record add Action code CPA and filing date of CPA in Completed Date field. If there is an outstanding Final Rejection, with a code of NAP, close the entry by placing the same date the CPA is filed in the Completed Date. Change record to Relation Type X. Enter application date of original application in Application Date field of CPA filing, ensuring proper calculation of expiration date of patent.

A Petition for Suspension of Action may also be submitted at the attorney's discretion.. In "Comments" for the CPA record add "Suspension of Action requested."

APPLICATIONS – REQUEST FOR CONTINUING EXAMINATION (RCE) (NON-PROVISIONAL)

A Request for Continuing Examination stays in the same file wrapper. Enter Action Code RCE and sent date. The serial number and filing date will remain the same. Any actions due, i.e., Response, Issue Fee, Notice of Appeal, Appeal to CAFC can be shut off as of the filing date of the RCE. **However, if the RCE is filed after the Issue Fee is paid, a Petition to Withdraw Payment of Issue Fee must be submitted.** Make 5 copies of the RCE form, as follows:

- 2 copies for the Deposit Account (stamp the copies DEPOSIT COPY and circle fee and account number in red)
- 2 copies for admin
- 1 copy for JKL for Deposit Account

APPLICATIONS - COMPLETION OF NONPROVISIONAL APPLICATION FOR WHICH DECLARATION AND ASSIGNMENT HAVE NOT BEEN SUBMITTED

The PTO mails a Notice to File Missing Parts of Nonprovisional Application for applications awaiting submission of Declaration. It is usually received before the docketed 2-month period of code FPA. The Declaration should be submitted at the end of the 2-month period if no notice has been received.

The Notice reads that the applicant is given two months from the date of the Notice of Missing Parts to file the declaration. In the existing FPA code, leave dates as originally entered. When formal papers have been signed, DJM makes one copy for admin for file wrapper and closes out the FPA code. DJM records the assignment and keeps declarations in her file. When Notice of Missing Parts is received, enter code NMP with Int. Action date 2 months from mailing date on Notice and Due Date 6 months from mailing date.

When Form 53 and declaration are ready for mailing, complete mailing certificate and xerox 5 copies:

Original and 2 copies to PTO marked DEPOSIT COPY (circle Deposit Account number and amount of fee in red)

2 copies to admin

1 copy to JKL for Deposit Account

MD Action: Add Action Taken date to FPA.

APPLICATIONS - MISCELLANEOUS INFORMATION

If Pharmacia & Upjohn is not the assignee and application is being mailed to outside inventors for review and execution, check with responsible attorney to determine if Assignment is to be executed at this time.

Upon return of case from outside inventors xerox 1 copy of Declaration (and Assignment if outside inventors are assigning to PUC) for admin file wrapper before mailing to PTO.

INFORMATION DISCLOSURE

For all US applications other than Provisional, MD system will automatically insert a code IDS and a due date of 3 months from filing date of application. The fee for filing an IDS is \$180.

Beginning 7/1/03 Information Disclosure Statements with US attachments will be filed electronically. The PTO will send an acknowledgement receipt. For the electronically filed IDS docket as below:

<u>Action</u>	<u>Due Date</u>	<u>Sent Date</u>	<u>Int. Action Date</u>	<u>Completed Date</u>	<u>Action Notes</u>
IDS	01JL2003	23JL2003	01JL2003	23JL2003	Electronic IDS

Hard copies of the foreign publications and articles will be sent by US mail. Add another code as follows:

<u>Action</u>	<u>Due Date</u>	<u>Sent Date</u>	<u>Int. Action Date</u>	<u>Completed Date</u>	<u>Action Notes</u>
IDS	01JL2003	23JL2003	01JL2003		Hard copies of foreign patents and articles

SUPPLEMENTAL INFORMATION DISCLOSURE

If a Supplemental Information Disclosure is filed, write in red ink over title on first page of transmittal "SUPPLEMENTAL" to avoid being charged.

MD Action: Add code SDS and Taken Date.

FILING RECEIPT

MD Action: When case is filed, add code FLR with Int. Action Date and Due Date 3 months from filing date. When Filing Receipt is received, add received date in Completed Date field.

MD Action: When Filing Receipt is received, add received date in Completed Date field. **Check to see if the Filing Receipt states that a Foreign Filing License has been granted. If it has not, attach a red sheet ("Please note that the Filing Receipt has been received and no Foreign Filing License has been granted.") to the front of the file wrapper. The case will then be given to the attorney for immediate attention. After the attorney has noted the Filing Receipt, the admin will file the notice on the center clip of the wrapper atop the Attorney Comments sheet.**

FILING RECEIPT CORRECTION

If Filing Receipt contains errors, add following two codes:

COR (Correction) and Int.Action Date and Due Date one month from receipt of Filing Receipt. In Action Notes add "Filing Receipt" add short description of correction.

CFR (Corrected Filing Receipt) and Int.Action Date and Due Date 3 months from date correction is requested.

OFFICE ACTION

When an Office Action is received, check "Parties" screen to determine attorney. Also check serial number against system to be sure it is the correct case. If a case number is not shown on the Action, check under Search Option "Country Code and Application Number." Write case number in red at right top of action.

Sometimes an Office Action is a Final Rejection in disguise and is not marked on the first page. Always look at the second or final page of the Office Action to see if it actually is a Final Rejection. If it is, see FINAL REJECTION below.

MD Action: Add code RES, Due Date (3 months from mail date of Action), and Deadline (6 months from mail date of Action). In "Notes" box, type "OA x/x/96."

Check references enclosed, if any, and write in red case number at right top of each reference followed by "A," "B," "C" ... (found as identifiers on PTO's accompanying yellow (but not always yellow) sheet.

RESTRICTION REQUIREMENT

A Restriction Requirement action indicates a 30 day, 1 month or 2 month time period for response. Write case number in red at right top of action. Write "ELECTION DUE month/day/year" in whatever white space is available below the line identifying the application.

MD Action: Add code ELE (election), Due Date (30 days or 1 month from PTO mailing date--watch 30-day docket because some months have 31 days and we must strictly adhere to 30 days), Deadline (6 months from PTO mailing date).

Occasionally, a 2-month response time is given. The Due Date would be 2 months from action date; the Deadline would be 4 months from Due Date. On even rarer occasions a 3-month time period is given for response. The Due Date would be 3 months from action date; the Deadline would be 3 months from Due Date.

When mailing Election to PTO, be sure that box "Response" is also checked on return postcard.

SEQUENCE REQUIREMENTS

Occasionally a notice of informality will be received in an application containing amino acid sequences.

MD Action: Add code RES, Due Date (1 month from date on notice), Deadline (4 months from Due Date). In Action Notes add "N/Incomplete App x/x/1996; send sequences."

FINAL REJECTION

Write case number in red at right top of action or circle case number in red, if the printed case number is legible. Also in red write "Notice of Appeal" and due date.

NOTE: If the current application is a CIP or CN, and if the first US filing date of the current application occurred prior to June 8, 1993, the application qualifies for a 129 Amendment (see below).

If the current application is a DV, and if the first US filing date of the current application occurred prior to June 8, 1992, the application qualifies for a 129 Amendment (see below).

When a Notice of Final Rejection is received (if the first page of an office action does not indicate Final Rejection, check last paragraph of remarks to see if message "THIS ACTION IS MADE FINAL" appears there):

If current application qualifies for a 129 Amendment, write "129 AMEND DUE month/day/year or APPEAL DUE month/day/year (both due dates 3 months from date of F/Rej)."

If current application DOES NOT qualify for a 129 Amendment, write only "APPEAL DUE month/day/year (3 months from date of F/Rej)."

MD Action: In Action Notes for NAP add F/REJ and date of F/REJ. This information may be needed after a 129 Amend or Notice of Appeal is submitted if an Advisory Action is received.

Add code 2MO and Int. Action Date and Due Date 2 months from date on F/Rej.

Add code NAP, Int. Action Date (3 months from date on F/REJ), and Due Date (6 months from date on F/REJ). In "Action Notes" box add "F/Rej x/x/1996 (PTO send date)."

The system will add the following codes for Appeal Brief:

- Appeal Brief
- Appeal Brief – 1 month
- Appeal Brief – 2 month
- Appeal Brief – 3 month
- Appeal Brief – 4 month
- Appeal Brief – final

For the first code, copy and paste the date from the Due Date field into the Int. Action Date. Close the other five codes with a 01JA2003 in the Completed field. These dates are temporary until the Notice of Appeal is actually filed.

When the Notice of Appeal has been filed and the PTO return post card is received, the Appeal Brief internal due date is changed to 2 months from the received date on the post card and 6 months from the received date on the post card. (In cases prosecuted by outside counsel, use their sent date in both fields.) It is now possible for an extension of up to 7 months. However, in the interest of timely filing, we use a drop dead date of 6 months.

See bolded note under heading "Final Rejection" above. If the 129 requirements are met, add code 129, Int. Action Date (3 months from date of Final Rejection), and Due Date (6 months from F/Rej).

If 129 requirements are NOT met, add only code NAP, Int. Action Date (3 months from date of F/Rej), and Due Date (6 months from date of F/Rej). In Notes box add "F/Rej x/x/1996 (PTO send date)."

When a 129 Amendment is filed, delete the action code NAP and due dates. If the 129 Amendment is rejected by Examiner, the NAP code and dates will be reinserted upon notice of rejection.

ADVISORY ACTION

When an Advisory Action is received following the filing of a Notice of Appeal in response to a Final Rejection, add another code NAP and Int. Action Date and Due Date as indicated by the Advisory Action.

If a Response to F/Rej is filed within 2 months of the mailing date of the F/Rej and the Advisory Action is not mailed until after the end of the 3-month shortened statutory period, then the shortened statutory period will expire on the date the Advisory Action is mailed, and any extension fee will be calculated from the mailing date of the Advisory Action. The Deadline must be 6 months from the mailing date of the Final Rejection (see date in code FRJ "Action Notes" box).

If the Advisory Action does not give a new due date, the due date is 3 months from the mailing date of the Final Rejection or as of the mailing date of the Advisory Action, whichever is later.

AMENDMENT OR RESPONSE

Check heading of document and verify completeness against system. An added claim may require an additional fee. Most responses can use transmittal form 111, 115 or 116, with original and 2 copies of transmittal (stamped DEPOSIT COPY) to PTO if claims fee or extension fee is needed.

MD Action: For code RES, add Action Taken date.

If response being sent to PTO is not a docketed response, add code COM (COMMUNICATION) and Action Taken date. If the submission is a Preliminary Amendment, in Action Notes add

RESPONSE TO FINAL REJECTION

All responses to Final Rejection must be sent to MAIL STOP AF.

If a 129 Amendment is filed:

MD Action: Modify code 2MO to read RES and in Action Notes for that code add "Response to F/Rej."

NOTICE OF APPEAL AND FEE

Mail to MAIL STOP AF.

Notice of Appeal form (191) is submitted in triplicate. Circle in red the \$310 fee and the deposit account number on the two deposit copies. Also, if the Notice of Appeal is filed in the fourth, fifth, or sixth month of the response period, on the deposit copies: With red pen, place a star or asterisk in the margin next to the "Extension of Time" paragraph. Under the star write the amount of the extension fee in red (1 mo - \$110; 2 mo - 400; 3 mo - \$920) and circle the deposit account number in red.

The attorney may file the Appeal Brief at the same time as the Notice of Appeal. If this is the case:

MD Action: For code NAP enter date sent under Action Taken date.
Add new code APB (Appeal Brief) and enter date sent under Action Taken date.

If the attorney is not filing the Appeal Brief now:

MD Action: For code NAP enter date sent under Action Taken date.

When PTO return postcard is received, IF Appeal Brief was not filed with Notice of Appeal, write on postcard "Appeal Brief due (2 months from NAP mailing date on postcard).

APPEAL BRIEF

Mail to MAIL STOP AF.

An Appeal Brief may be filed based on the decision of the attorney. If attorney decides not to file, remove APB code from record and add RMK code under Text: "Atty will not file Appeal Brief" and date of attorney's decision.

The Appeal Brief is due 2 months from the Notice of Appeal PTO post card received date. It is filed in triplicate using Form 192 with a fee of \$310. Look at box electing Oral Hearing to see if it is checked. An Oral Hearing can be requested at the attorney's discretion.

EXAMINER'S ANSWER

When Examiner's Answer is received, docket Reply Brief (directed only to such new points of argument listed in examiner's answer) for **2 months** from mailing date stamped on Examiner's Answer.

Form 193 is completed if filing a Reply Brief **and** a Request for Oral Hearing.

Form 193.B is completed if filing a Reply Brief only.
Form 194 is completed if filing a Request for Oral Hearing only.

MD Action: Add new code RPB (Reply Brief) with Due Date 2 months from date stamped on Examiner's Answer.

Add new code ROH (Request Oral Hearing) with Due Date **2 months** from Examiner's Answer.

If attorney decides not to request an Oral Hearing, remove code and dates from docket.

REPLY BRIEF AND REQUEST FOR ORAL HEARING

Mail to MAIL STOP AF.

Form 193 is completed if filing a Reply Brief (\$300) **and** a Request for Oral Hearing (\$260).
Form 193.B is completed if filing a Reply Brief (\$300) only.
Form 194 is completed if filing a Request for Oral Hearing (\$260) only.

MD Action: Retrieve RPB and add Action Taken date. **The Brief must be filed in triplicate. If attorney decides not to file a Reply Brief at this time, leave code and dates on docket.**

MD Action: Retrieve ROH and add Action Taken date. If attorney decides not to request an Oral Hearing, delete code and dates from docket.

NOTICE OF HEARING

When Notice of Hearing is received, the attorney must notify the PTO within 21 days from date stamped on notice whether the hearing is being **confirmed** or **waived**. A copy of the PTO notice must accompany the attorney's reply to the PTO.

MD Action: Add code CHD(Confirm of Hearing Date) and add Due Date for 21 days from date stamped on Notice of Hearing.

Add code HRG (Oral Hearing) and add Due Date (printed at top right of Notice of Hearing in both Int. Action Date and Due Date fields). This block of information also lists location and time of the hearing.)

On Notice of Hearing write "Confirm Oral Hearing by 21 days from date stamped on notice."

After hearing date has passed, add date of hearing as Completed Date.

DECISION ON APPEAL

If Decision is "AFFIRMED," a REQUEST FOR RECONSIDERATION may be filed within 1 month of Decision or APPEAL TO CAFC within 2 months of decision. If reconsideration is requested, APPEAL TO CAFC is due 2 months from date of Decision or 30 days from action on request for reconsideration, whichever is later.

MD Action: Add code REQ (Request) and add Action Due Date 1 month from mailing date on Decision. Same Deadline Date. No extensions are possible. In Action Notes add "Request for

Reconsideration.”

MD Action: Add code CAF (Appeal to CAFC) and add Action Due Date 2 months from mailing date on Decision. Same Deadline Date. No extensions possible.

REQUEST FOR RECONSIDERATION OR REHEARING

Mail one copy of request to PTO. **Mail to Mail Stop AF.**

DECISION ON REQUEST FOR RECONSIDERATION OR REHEARING

When Decision is received, docket in both Int. Action Date and Due Date for 30 days from PTO mail date for APPEAL TO CAFC. No extensions possible.

NOTICE OF DRAWINGS DUE

Occasionally a Notice of Drawings Due will be received. If it is received during the prosecution of the case, a code DRG (Drawings Required or Due) will be entered with Int. Action Date of 3 months and Due Date of 6 months from the notice.

If the Notice of Drawings Due is received with the Notice of Allowance, the code DRG will be entered with Int. Action Date and Due Date 2 months before due date printed on the Notice of Allowance.

IDENTIFICATION OF DRAWINGS

Identifying indicia should include the title of the invention, inventor's name, application number (if already assigned), docket number (if an application number has not been assigned to the application.) This info must be placed on the front of each sheet and centered within the top margin.

NOTICE OF ALLOWANCE

The Issue Fee will be docketed for payment at least 10 days before due date printed on the Notice of Allowance. (On my wall calendar I prefer to pay the Issue Fee on Friday. If 10 days does not fall on a Friday, back date up to the previous Friday, never allowing less than 10 days.) Stamp "Issue Fee Due" and write due date in red on top page of Notice of Allowance form. The Notice is usually the third paper in the packet.

Also, add code "DIV" (Divisional Application) to record with both due dates the same as on Issue Fee entry.

<u>Action</u>	<u>Due Date</u>	<u>Int. Action Date</u>	<u>Action Notes</u>
DIV	20OCT2002	10OC2002	File before Issue Fee payment date, 10/20/02

If attorney decides a divisional will not be filed, shut off entry with 01JA2002 and a note that attorney will not file a divisional and date of that decision. Check MD system to confirm attorney assigned.

Complete form M:\LISTS\ISSUE.doc, typing in information at *. (See instructions below for submission to PTO of Fee Address form.) The second page of this form contains the Express Mail certificate. Select and copy top part of first page (Docket Number at top right down to "Commissioner for Patents") and paste at top of second

page of form. Print.

Complete form M:\LISTS\ISSUEFEE.PAY.doc, typing in information at *. There is also a question on M:\LISTS\ISSUEFEE.PAY.doc, "HAVE ALL PLANNED DIVISIONALS OF THIS CASE BEEN FILED? Divisional filing has been docketed for _____. (same date as mailing date of Issue Fee). Please inform JKL if a divisional will not be filed." Print form.

Write the date the fee will be mailed on wall calendar in JKL's office.

Give packet (attached to file wrapper by rubber band) consisting of following to attorney's admin.

M:\LISTS\ISSUEFEE.PAY.doc form

M:\LISTS\ISSUE.doc form, first page--Fee Address form. (The second page--Express Mail certificate--will be retained by DJM.)

Notice of Allowance and accompanying pages

MD Action: Add code ISS. Int. Action Date will be 10 days before due date given on Notice of Allowance. Due Date will be due date given on N/Allow. In "Notes" box add "N/Allow x/x/1998 (date on Notice).

Add code DIV (Divisional Application) and Due Date and Deadline Date also 10 days before due date given on Notice of Allowance. Attorneys will inform JKL if a divisional is to be filed. If it is not, JKL will remove the due dates.

PATENT TERM ADJUSTMENT

In applications filed on or after May 29, 2000, a Determination of Patent Term Adjustment can be made by the PTO. If a Determination of Patent Term Adjustment is made, enter code PEX with an Internal Action Date of two months from the date the issue fee is paid and a Due Date of three months from the date the issue fee is paid. Responsible Atty: DJM. In Action Notes add "Pat Term Adjustment -- days." If a PEX is not made, docket no code.

In the Issue Fee Due code, also add in Action Notes "Pat Term Adjustment -- days."

When ribbon and soft copies of the issued patent are received, add Completed Date to PEX code. Add PEX code to Actions. Save. Returning to first screen, change Patent Expiration Date to the extended date. Save.

The new expiration date can be figured quickly in Excel:

10/26/20 Original expiration date (calculated by system)

56 Number of days extension

12/21/20 Click Total, move curser up to include first date, click Total again; new Expiration Date appears

"FEE ADDRESS" INDICATION FORM

The "Fee Address" Indication form contains the Customer Number 30506 for the following address. If the address changes, the PTO will need to be informed.

Maintenance Fees

Payor No. 000124
Master Data Center
300 Franklin Center
29100 Northwestern Highway
Southfield MI 48034-1095

The Fee Address form is submitted with the Issue Fee by checking the Fee Address box (in Box 1 of the Issue Fee transmittal).

"FEE ADDRESS" INDICATION FORM for OUTSIDE COUNSEL CASES

Beginning 8/29/02, we will also submit all Fee Address forms for cases being prosecuted by outside counsel. Complete the first page of form Issue.doc (Issue Fee Address form).

In cases handled by outside counsel, check to be sure all of our attorneys are also named in their powers of attorney. If they are not, notify outside counsel to add them. However, to be timely, if the appropriate inside attorney is not named, complete the Fee Address form to be signed by one of the inside named attorneys.

PAYMENT OF ISSUE FEE

On day Issue Fee is to be mailed, complete Express Mail certificate. On Express Mail envelope label at "MAIL STOP _____:" on top line of preprinted address, write in ISSUE FEE. Make 2 copies of Express Mail certificate, 1 for JKL and 1 for admin.

Mail following packet:

Completed Express Mail certificate
Signed Fee Address form
Issue Fee PTO form (85B) plus one photocopy stamped DEPOSIT COPY and the fee and deposit
account number circled in red
Return postcard

MD Action: Add Action Taken date to ISS action.

Deposit Account:

Add Issue Fee (Code 1501, \$1,300) to deposit account (m:\excel\dep.xls).
Add fee for soft copies (Code 8001, \$30) to deposit account.
If Publication Fee (\$300) is indicated on Issue Fee, add Code 1504, \$300, to deposit account.

ASSIGNMENT PREPARATION

Kalamazoo and New Jersey inventors assign to Pharmacia & Upjohn Company.

Italian inventors assign to Pharmacia & Upjohn SpA.

Swedish inventors assign to Pharmacia & Upjohn AB.

We prefer to have all of the inventors assigning to the same entity listed on our documents even if all of them will not be signing the same copy of the document, i.e., inventors in New Jersey may be signing separate

documents (due to time crunch, etc).

Example: four inventors, 2 Kalamazoo, 2 New Jersey.

Prepare two copies of the Assignment listing all four inventors. The assignment for the Kalamazoo inventors will have signature lines for only the two Kalamazoo inventors and the New Jersey document will have only signature lines for the two New Jersey inventors.

When we have joint inventorship with Italy an equivalent of a foreign filing license must be obtained from the Italian Patent Office. This document is called an Export License.

ASSIGNMENT RECORDAL

Nonprovisional assignments will be recorded at the time the application is filed, if all inventors are available to sign. In the event the inventors are not available to sign the declaration and assignment when the case is filed, the papers will be prepared when the serial number is received and then recorded in the PTO by fax (m:\30.PAT FAX.doc. **In Box 3 of recordal form, Execution Date of the assignment is the latest date any of the inventors signed the document.**

If assignment is recorded by mail, use m:/3-PAT.doc. Legal Assistant can sign the form. (JKL, DAT, DJM and RAL are currently authorized on the PTO Deposit Account.) The present fee is \$40 per assignment and where possible all inventors will be listed in one assignment document.

Make one copy of signed form 30.pat, for JKL for recording in Deposit Account record. As of 1/1/96 it is no longer necessary to send an extra copy to the PTO for the Deposit Account. The original cover sheet is scanned electronically and examination is performed using computer generated images. A "Notice to Finance" is generated whereby the fee will be charged to the Deposit Account. We will receive a copy of the "Notice to Finance" along with the Notice of Recordation.

RECORDED ASSIGNMENT

On first screen in MIPS record, under box "Assigned," select "Assignment Recorded." No entry necessary under "Actions."

If the Assignment is recorded by fax, the PTO will send faxed notification, listing reel and frame number and date of recordal.

DJM will place the PTO Notice of Recordal and original Assignment in the ribbon folder.

INACTIVATION BEFORE FILING

A Proposed Inactivation of an Invention Disclosure will be circulated by attorney.

MD Text: Optional: Note can be added to explain inactivation.

Main: Change Status to "I" (INACTIVE). Expiration Date is date of inactivation notice.

ABANDONMENT AFTER FILING

When a Proposed Abandonment is received, it will be placed on the attorney docket as code ABN. With the proposed abandonment date as the Action Due Date. When approval is received for abandonment, the attorney will in most cases prepare an Express Abandonment. If an Express Abandonment is filed, add "Express Aban" in "Remarks" under code ABN, add send date and change Status to "I" and Substatus to "B." When return postcard is received, enter PTO stamped received date as Expiration Date on record. Change Status to "I" and Substatus to "B."

If an Express Abandonment is not filed, and the final date for response has passed, change the Status to "I" and Substatus to "B" and record the Expiration Date as the same date for final response. Indicate in Action Notes for Response attorney's decision not to file Express Aban and date of decision.

ISSUE NOTIFICATION

This is notification that a patent is about to issue. DJM will check information carefully against system.

MD Action: Add code INA and use date received as Completed Date.

Main: Add patent number and issue date. Save. The system will change the status to "G" and will add the expiration date.

If Patent Term Adjustment has been applied, write on face of Issue Notification, "Expiration Date adjusted to December 26, 2020 (appropriate date)."

Beginning January 1999 the PTO must issue a patent within four months of the issue fee payment date. If it does not, the expiration date of the patent is extended by one day for each day beyond that limit until the date the patent issues.

RIBBON PATENT and SOFT COPIES

These will be processed by DJM. Do not date stamp original Letters Patent.

At top right of ribbon patent write the case number in ink.

Place the ribbon patent in Ribbon Patent file.

Give one soft copy to admin for file wrapper (write case number in pencil at top right).

MD action: Add code PAT and date received in Completed Date. Usually, the ribbon patent and 10 soft copies are received on the same date. If they aren't, the ribbon patent will arrive first and the 10 soft copies a few days later (so that envelope will have a different received date). When soft copies are received add note in Action Notes: "Soft copies received + date."

STATUTORY INVENTION REGISTRATION (SIR)

The SIR looks like a patent ribbon copy, but it is not a patent. It has the defensive attributes of a patent but does

not have the enforceable attributes of a patent. Make a copy for the file wrapper and put the original in the ribbon patent folder.

Add Action Code SIR. Change Status to "G" for granted. The SIR code will prevent the system from adding an expiration date and tax due dates.

PATENT TERM EXTENSION

Send copy of all correspondence sent or received re patent term extensions to Bruce A. Pokras, NJ.

Patent Term Extension is requested by use of form 156 and filing fee is \$1,240.

MD Main: If patent is not ours, create new record with case type "J." Add patent number being extended under Parent # field. Add code for owner in Current Owner field. In some cases, a new code for Current Owner will need to be created: File, New, Parties, Owner. See 5010 for example.

If patent IS ours, add case type "J" to the existing record.

Parties: P&U attorney assigned to case.

Action: Add code FIL with Due Date 30 days (counting date of notice as first day) and Deadline date 30 days from Due Date. In Action Notes add: "App for patent term extension" or "App for interim patent term extension."

Text: Add date of notice.

When extension is granted, add action code PEX. This will notify the system that the extension has been granted. Then manually type in new expiration date. The Tax Base Date and Next Tax Date will remain unchanged.

INTERFERENCE

When a notice of potential interference (Suspension of Action) in which it is stated "due to a potential interference, ex parte prosecution is suspended":

MD Action Enter code STA with Int. Action Date and Due Date 6 months from sent date on PTO notice.

If an interference is declared, prosecution will usually be undertaken by outside counsel.

When notice is received from Board of Patent Appeals and Interferences that interference is ready for termination processing:

MD Action Enter new code STA with Int. Action Date and Due Date 6 months from sent date on PTO notice.

When Notice of Termination of Interference is received:

MD Action Enter code ____ with PTO sent date as Completed Date.

REISSUE APPLICATION

When a Reissue Application is filed, create a new record by copying the old record and inserting Case Type "R." In the new record, move the Patent Number to the Parent Number field. Move the Grant Date to the Parent Date field. Application Date is date filed. The PTO will issue a new serial number. At this time inactivate the old record. Under "Text" add RMK: INACTIVATED IN FAVOR OF REISSUE APPLICATION, (date inactivated).

TERMINAL DISCLAIMER

If two of our patents have issued, both claiming the same matter, same inventors, etc., a Terminal Disclaimer will be filed shortening the expiration of the latest issued patent to the expiration of the first issued patent.

Example:

4,000,000 Expiration date 1/1/2000

4,000,001 Expiration date 12/1/2010; however, if a Terminal Disclaimer was filed based on 4,000,000, the expiration date of this patent would be manually entered as 1/1/2000.

The terminally disclaimed patent will contain a notice from the PTO: "The portion of the term of this patent subsequent to January 1, 2000 has been disclaimed." If the PTO doesn't list the date, it will be the expiration date of the first patent.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent No. 4,902,683

Patentees : Amin et al.
Assignee : Pharmacia & Upjohn Company
Issue Date : February 20, 1990

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Box Petition.

DECLARATION

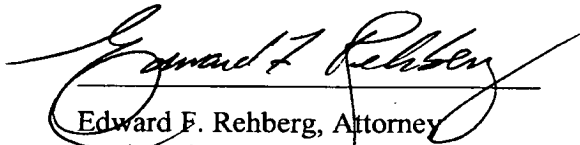
I, Edward F. Rehberg, declare and say as follows:

1. I, Edward F. Rehberg, residing at 8969 W. R Avenue, Kalamazoo, Michigan 49009 am employed as a patent attorney by the Pharmacia & Upjohn Company ("the Applicant") as in-house patent counsel. I am admitted to the bar of New York state and the U.S. Patent Office.
2. On March 3, 2004 I was performing a routine database search of issued U.S. Patents using the LEXIS-NEXIS in the ordinary course of my duties at Pharmacia & Upjohn.
3. My search retrieved a citation for United States Patent No. 4,902,683.
4. On examining the citation I noted that the citation for United States Patent No. 4,902,683 was annotated to indicate that the patent had lapsed for failure to pay maintenance fees.
5. I immediately called the US Patent Office to confirm the LEXIS-NEXIS annotation and was informed that United States Patent No. 4,902,683 had lapsed.
6. I thereafter asked Ms. Lyons of our office to ask Master Data Center why the maintenance fees for United States Patent No. 4,902,683 had not been paid.
7. I had no prior notice that United States Patent No. 4,902,683 had lapsed.
8. I was informed by Deborah Tucker of our office that some of the files relating United States Patent annuity matters were contained in files that had been transferred to our

Morristown, NJ office on or about February 13, 2004 or had been retained in Kalamazoo, MI

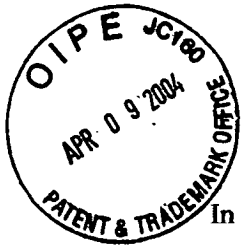
9. I have examined our files both in Kalamazoo, MI and Morristown, NJ and can find no evidence that Pharmacia & Upjohn ever received notice of the expiration of United States Patent No. 4,902,683.
10. I believe my conduct in this matter has been reasonable and that I have taken steps to assure that a petition to reinstate United States Patent No. 4,902,683 will be promptly filed.

I hereby declare that all statements made herein are of my own knowledge, and I believe them to be true, and further that these statements are made with the knowledge that willful false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.


Edward F. Rehberg, Attorney
Registration No. 34,703
Pharmacia & Upjohn Company
Global Intellectual Property
301 Henrietta Street
Kalamazoo, Michigan 49001

4.01.04
Date

4



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent No. 4,902,683

Patentees : Amin et al.
Assignee : Pharmacia & Upjohn Company
Issue Date : February 20, 1990

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: Box Petition.

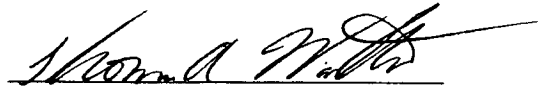
DECLARATION

I, Thomas A. Wootton, declare and say as follows:

1. I, Thomas A. Wootton, residing at 6369 Whitney Woods, Richland, Michigan 49083, I have been employed as a patent attorney by the Pharmacia & Upjohn Company ("the Applicant") as in-house patent counsel since 1 April 1991. I am admitted to the bar of Michigan state and the U.S. Patent Office.
2. In the summer of 2003, I was promoted to Group and Site Leader of the Kalamazoo Intellectual Property Department after the acquisition of Pharmacia and Upjohn by Pfizer Inc.
3. On March 3, 2004 I was informed by Ed Rehberg, a patent attorney under my supervision, that it appeared that United States Patent No. 4,902,683, had lapsed for failure to pay maintenance fees.
4. Mr. Rehberg and I confirmed that this lapse of the patent was contrary to the Applicant's desires and intention, and had never been instructed.
5. I directed and supervised a prompt review of the department procedures to determine how it was possible for such a lapse to happen.
6. This review included discussions with in-house docket administrators, Deborah Tucker, Julie Lyons, and inside counsel Ed. Rehberg.
7. I directed Ed Rehberg to review all relevant files both in Kalamazoo and in Morristown, NJ, where some of the files relating to United States Patent annuity matters were transferred from our office on or about February 13, 2004.

8. I believe the failure to pay the 12 year maintenance fees on this patent was unavoidable given that the Applicant had redundant systems in place specifically designed to pay the fee, including a system to double check that if a fee on a pending patent was not paid, then lapse of a patent could only occur if the non payment was deliberately not paid rather than because of a mistake. This information is evidenced by the declarations of both Julie Lyons and Deborah Tucker.
9. I further believe the absence in the company files of any notice of pending lapse or failure to pay the maintenance shows that this lapse was unavoidable.
10. I promptly directed Daniel A. Boehnen and Donald Zuhn at McDonnell, Boehnen, Hulbert and Berghoff to research the law and prepare and file a petition with the USPTO to request United States Patent No. 4,902,683, be reinstated in full force and effect.
11. I believe my conduct in this matter has been reasonable and that I have taken steps to assure that a petition to reinstate United States Patent No. 4,902,683 will be promptly filed.

I hereby declare that all statements made herein are of my own knowledge, and I believe them to be true, and further that these statements are made with the knowledge that willful false statements so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.



Thomas A. Wootton, Attorney
Registration No. 35,004
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Global Intellectual Property
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Kalamazoo, Michigan 49001


Date